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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,003	06/06/2000	Thomas Muller	006918.00007	8997
22907 7590 02/18/2009 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER ZIA, SYED	
			ART UNIT 2431	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/588,003

**Applicant(s)**

MULLER ET AL.

**Examiner**

SYED ZIA

**Art Unit**

2431

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9, 27, 29 and 33-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 27, 29, 43-44, and 51 is/are rejected.
- 7) ☒ Claim(s) 33-42, 45-50 and 52-58 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)             |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Inventor's Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                            |

## **DETAILED ACTION**

This office action is in response to amendment and remarks filed on December 3, 2008.  
The amendments filed have been entered and made of record.

### ***Allowable Subject Matter***

2. Claims 33-42, 45-50, and 52-58 are objected to as being dependent upon a rejected base claim, but would be allowable if all corresponding objected claim(s) are merged and rewritten in independent form including all of the limitations of the base claim and all intervening claims, and also subject to overcoming new 35 U.S.C. 101 rejection .

### ***Response to Arguments***

Applicant's arguments filed December 3, 2008 have been fully considered but they are not persuasive because of the following reasons:

Regarding Claims 9 and 27 applicants argued that in the system of cited prior arts [Dascalu U. S. Patent 6,754,713] “Dascalu "an authentication component configured to authenticate a communicating device and "an access control component accessible by a communicating device requesting access to the first application without the communicating device having been authenticated by the authentication component, and arranged to arbitrate whether access of the communicating device to the first application is granted or refused wherein if the arbitration requires an authentication of the communicating device, the access

*control component configured to instruct the authentication component to authenticate the communicating device, wherein the access control component is configured to receives indications originating from the communicating device identifying the communicating device and the application requested".*

This is not found persuasive. The system of cited prior art, the Protocol Scanner, is a set of software routines that scans data in Received Data Buffer and compares it with Access Rules to determine whether the message is permitted or not. When Protocol Scanner detects an event which is not permitted, Protocol Scanner generates a message which will terminate the communication session in which that event took place. And if Protocol Scanner detects that an event not permitted according to Access Rules occurred over the network, a session wall issues a message which will terminate that communication session. Accordingly, a session wall sends a message to both parties involved in the session. In a message to the server, a session wall either notifies that the client wishes to close the current session, or it sends a specific "terminate session" message to the server using the particular communication protocol used by the server. That message causes the server to stop responding to additional client messages in that specific session (col. 4 line 25 to col. 5 line 67).

Thus, the system of cited prior art provides a system that relates to system security architecture for devices which are accessed through a communication network. Therefore, the examiner asserts that the system of cited prior arts does teach or suggest the subject matter broadly recited in independent Claims 1, 27, 29, 43, and 51 and in subsequent dependent Claims. Accordingly, rejection for claims 9, 27, 29, 43-44, and 51 is respectfully maintained.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 29, 43, 38-42, 44-50, and 57-58 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 29, 43, 38-42, 44-50, and 57-58 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

3. Claims 43-50, and 57-58 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Claims 43-50, and 57-58 are not statutory because they are directed towards a method accessing an application without authenticating the requesting device which could be implemented via software alone, thus interpreted as software per se, however, the claims fail to assert the program recorded on an appropriate computer-readable medium so as to be structurally and functionally interrelated to the medium and permit the function of the descriptive material to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer without a computer-readable medium needed to realize the computer program's functionality, it is regarded as nonstatutory functional descriptive material. See MPEP 2106.01 for details.

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). See MPEP 2106.01

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 9, 27, 29, 43-44, and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Dascalu U. S. Patent 6,754,713.

Regarding Claim 9 teaches and describes a apparatus (Fig.1-3, col.2 line 20 to col.3 line 60), comprising: at least a first application; an authentication component configured to authenticate a communicating device; an access control component accessible by a communicating device requesting access to the first application without the communicating device having been authenticated by the authentication means, and arranged to arbitrate whether access of the communicating device to the first application is granted or refused wherein if the arbitration requires an authentication of the communicating device, the access control component configured instructs the authentication component to authenticate the communicating device, wherein the access control component is configured receives indications originating from the

communicating device identifying the communicating device and the application requested (col.4 line 25 to col.5 line 67).

Regarding Claim 27 Dascalu teaches and describes a apparatus ((Fig.1-3, col.2 line 20 to col.3 line 60), comprising: at least first and second applications; authentication component for authenticating a communicating device; first access control component accessible by a communicating device requesting access to the first application without the communicating device having been authenticated by the authentication means, and arranged to arbitrate whether access of the communicating device to the first application is granted or refused wherein if the arbitration requires an authentication of the communicating device, the access control component configured to instructs the authentication component to authenticate the communicating device; second access control component configured to accessible by a communicating device requesting access to the second application without the communicating device having been authenticated by the authentication means, and arranged to arbitrate whether access of the communicating device to the second application is granted or refused wherein if the arbitration requires an authentication of the communicating device, the second access control component instructs the authentication component to authenticate the communicating device, wherein the first access control component is accessible by a communicating device requesting access to the second application without the communicating device having been authenticated by the authentication means, and is arranged to provide the access of the communicating device to the second access control component (col.4 line 25 to col.5 line 67).



Regarding Claim 29 Dascalu teaches and describes a method of arbitrating the access of a requesting device to a service provided by a providing device ((Fig.1-3, col.2 line 20 to col.3 line 60) comprising: sending a request to access the service from the requesting device to the providing device; receiving the request at the providing device and passing it, without authenticating the requesting device, to an arbitration component interfacing the service; determining, in the arbitration means, whether to grant or refuse access to the first application by the requesting device, wherein if the determination requires an authentication of the requesting device, the authentication is performed during that determination and not previously, wherein the determination is made on the basis of the identity of service requested and/or the identity of the requesting device (col.4 line 25 to col.5 line 67).

Regarding Claim 43 Dascalu teaches and describes a method comprising: receiving a request to access an application and passing it, without authenticating the requesting device, to an arbitration component interfacing the service; and determining, in the arbitration component, whether to grant or refuse access to the application, wherein if the determination requires an authentication of the requesting device, the authentication is performed during that determination and not previously, wherein the determination is made on the basis of the identity of the application requested (col.4 line 25 to col.5 line 67).

Regarding Claim 51 Dascalu teaches and describes a computer readable storage medium encoded with instructions that, when executed by a processor, perform (Fig.1-3, col.2 line 20 to

col.3 line 60): receiving a request to access an application and passing it, without authenticating the requesting device, to an arbitration component interfacing the service; and determining, in the arbitration component, whether to grant or refuse access to the application, wherein if the determination requires an authentication of the requesting device, the authentication is performed during that determination and not previously, wherein the determination is made on the basis of the identity of the application requested (col.4 line 25 to col.5 line 67).

As per Claim 44, Dascalu teaches and describes a method wherein the determination is made on the basis of the identity of the requesting device (col.5 line 5 to line 20).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SYED ZIA whose telephone number is (571)272-3798. The examiner can normally be reached on 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sz

February 16, 2009

/Syed Zia/

Primary Examiner, Art Unit 2431